REMARKS

Claims 1 to 20 are now pending.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

Claims 19 and 20 were rejected under 35 U.S.C. § 112, first paragraph, as to the enablement requirement.

As regards the enablement requirement, the standard for determining whether a patent application complies with the enablement requirement is that the specification describe how to make and use the invention — which is defined by the claims. (See M.P.E.P. § 2164). The Supreme Court established the appropriate standard as being whether any experimentation for practicing the invention was undue or unreasonable. (See M.P.E.P. § 2164.01 (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); *In re Wands*, 858 F.2d. 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed Cir. 1988))). Thus, the enablement test is "whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." (See *id.* (citing *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).

The Federal Circuit has made clear that there are many factors to be considered in determining whether a specification satisfies the enablement requirement and that these factors include but are not limited to the following: the breadth of the claims; the nature of the invention; the state of the prior art; the level of ordinary skill; the level of predictability in the art; the amount of direction provided by the inventor; the existence of working examples; and the quantity of experimentation needed to make or use the invention based on the disclosure. (See *id.* (citing *In re Wands*, 858 F.2d at 737, 8 U.S.P.Q.2d at 1404 and 1407)). In this regard, the Federal Circuit has also stated that it is "improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors," and that the examiner's analysis must therefore "consider all the evidence related to each of these factors" so that any nonenablement conclusion "must be based on the evidence as a whole." (See M.P.E.P. § 2164.01). It is respectfully submitted that the Final Office Action has not addressed these factors.

It is believed that the present assertions of the Final Office Action do not meaningfully address — as they must under the law — whether the present application enables a person having ordinary skill in the art to practice the claimed subject matter of claims 19 and 20 without undue experimentation, which it plainly does. The gist of this rejection is that the Examiner is unable to determine where in the Specification mutual exclusivity of transmission of data as event-oriented data and according to a deterministic operation or selection of the different transmissions is discussed, but it is respectfully submitted that one skilled in the art would readily understand (without undue experimentation) that the features of claims 19 and 20 are described in the Specification; for example, at page 12, line 22 to page 13, line 19.

Specifically, the Specification describes that an event-controlled transmission is implemented to the exclusion of a deterministic transmission operation as long as a critical state is not determined. When a critical state is determined, the transmission operation is switched over to a deterministic operation that does not include an event-controlled transmission. This is maintained until a determination is made, when the deterministic operation is completed, to switch back to the event-controlled transmission. When any of the two transmissions is in operation, the other is not in operation. The transmissions, and the selections thereof, are mutually exclusive.

It is therefore respectfully submitted that the Specification enables one skilled in the pertinent art to practice the claimed subject matter of claims 19 and 20 *without undue experimentation*, and that claims 19 and 20 comply with the enablement requirement of 35 U.S.C. § 112. Withdrawal of the enablement rejections is therefore respectfully requested.

Claims 1 to 20 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,706,278 (the "Robillard" reference).

As regards the obviousness rejections of the claims, to reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application

disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 1 relates to a method of exchanging data between at least two users that are interconnected over a bus system. Claim 1 as presented provides for transmitting the data as event-oriented data as long as a preselectable latency is ensured for each message to be transmitted, and "if, and conditional upon that, the preselectable latency . . . is not ensured for each message to be transmitted, transmitting the data . . . according to a deterministic operation." Claims 11, 12, and 15 include subject matter like that of claim 1.

As explained in Applicants' Response, filed July 5, 2005, while the "Robillard" reference discusses a combination of a time-slot allocation protocol (referred to by the Final Office Action as allegedly disclosing the deterministic operation) and a contention-based protocol (referred to by the Final Office Action as allegedly disclosing the transmission of data as event-oriented data), any review of the "Robillard" reference makes plain that the time-slot allocation protocol is used for all transmissions. It is not used "conditional upon that" a preselectable latency is not ensured. In this regard, the "Robillard" reference states that a plurality of time slots are generated in which all messages are transmitted. For each node that transmits critical messages, one or more time slots are assigned to the node for transmitting the critical messages. An additional time slot is provided that is not assigned to any particular node, and during which non-critical messages of all nodes are transmitted. Column 3, lines 36 to 62. Thus, the time-slot allocation protocol is used for all data transmissions, and the use of the time-slot allocation protocol is not upon a condition that a preselectable latency is not ensured.

In the Final Office Action, the Examiner asserts that "[o]ne of ordinary skill in the art would have recognized that regardless of whether or not the preselectable latency is ensured, the time slot applies to all conditions, therefore Robillard reads onto the condition as claimed." The Examiner has apparently misconstrued the language "upon a condition" of claims 1, 11, 12, and 15 to mean that the data is transmitted over the bus system according to a deterministic operation when the condition of the bus system is such that the preselectable latency elapsing between the transmission request by the one of the users and the effected

transmission operation of the one of the users is not ensured for each message to be transmitted. Claims 1, 11, 12, and 15 have been amended herein without prejudice to clarify that data is transmitted according to the deterministic operation only if there is satisfaction of a certain condition, *i.e.*, that the preselectable latency elapsing between the transmission request by the one of the users and the effected transmission operation of the one of the users is not ensured for each message to be transmitted. Indeed, the Examiner clearly indicates that the "Robillard" reference does not disclose this feature when the Examiner states that, with respect to the "Robillard" reference, the time slot applies to all conditions, "regardless of whether or not the preselectable latency is ensured," *i.e.*, even when it is ensured.

Thus, the "Robillard" reference does not disclose or even suggest all of the features recited in any of claims 1, 11, 12, and 15 as presented, so that these claims are allowable.

Claims 2 to 10, and 19 ultimately depend from claim 1 and are therefore allowable for the same reasons as claim 1. Claim 20 depends from claim 11 and is therefore allowable for the same reasons as claim 11. Claims 13 and 14 depend from claim 12 and are therefore allowable for the same reasons as claim 12. Claims 16 to 18 ultimately depend from claim 15 and are therefore allowable for the same reasons as claim 15.

It is therefore respectfully requested that the anticipation rejections of claims 1 to 20 be withdrawn.

Accordingly, claims 1 to 20 are allowable.

Conclusion

In view of the foregoing, it is respectfully submitted that all of claims 1 to 20 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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